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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,595	12/05/2001	Lance E. Anderson	10112014	5140
7590	04/15/2005		EXAMINER	KOHNER, MATTHEW J
John F. Klos, Esq. Fulbright & Jaworski L.L.P. Suite 2100 80 South 8th Street Minneapolis, MN 55402-4320			ART UNIT	PAPER NUMBER
3653				
DATE MAILED: 04/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/004,595	ANDERSON, LANCE E.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Matthew J Kohner	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 December 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 13-27 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12, 28 and 29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 December 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Election to Invention***

Examiner acknowledges Applicant's election, without traverse, of Group I (claims 1-12 and 28-29) drawn to an apparatus comprising a mail sorting device and folder device.

Applicant has amended the claims of Group II (claims 13-27), "so as to be drawn to the subject matter of the claims of Group I" (Applicant's remarks, page 10). However, the restriction is still proper for the reasons given in the restriction requirement (See page 2, last 3 lines [i.e. the apparatus of claims 1, 7 and 28 does not require inverting of the folders]). Therefore, the restriction is now made final.

***Response to Amendments / Arguments of the June 11, 2004 "Reply to Office Action"***

In light of Applicant's amendments and arguments the rejections of the previous office action are withdrawn.

However, the drawing objection under 37CFR 1.83(a) regarding the "postage paid mail item" is maintained. Applicant has argued, that Figs. 7 and 8 and lines 17-20 of page 7 of the specification describe folder 30 so that it may be a postage paid mail item. Further, applicant states, "when empty and flat, folder 30 could properly be sent through the mail. (Applicant's remarks, page 16)"

Page 7, line 17 *et seq.* reads,

"in one embodiment of the present invention, the dividers 30 are postage paid mailing items which are processed as regular mail items. In yet another embodiment, the dividers 30 include address specific information 38 and are sorted with reference to the information, but not otherwise being a postage carrying item. In the uppermost illustration of FIG. 7, each of the dividers 30 is placed in a predetermined relationship relative to the balance of the mail subgrouping 52, i.e., the dividers 30 are disposed adjacent the right-most mail item 32 of the

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subgrouping. Alternatively, the dividers 30 may be disposed adjacent the left-most mail item 32 of the subgroupings 52."

Neither this wording nor Fig. 7 and 8 disclose how these folders 30 are postage paid mail items. Further, Examiner disagrees with applicant that empty open folders could be properly sent though the mail.

Additionally, in light of applicant's drawing correction, a new drawing objection is required. By changing reference numeral 44 to 46, applicant has disclosed the fold line. However, the drawings do not show the "splay structure" of claims 5 and 11.

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "postage paid mail item" (claims 4 and 10) and the "splay structure" (claims 5 and 11) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 4 and 10 state that the folder device is a postage paid mail item. However, the independent claims from which they depend (1 and 7) recite that the folder device has forward edges of the sides at differing heights. Applicant's Fig. 4 shows an example of this with the reveal structure 40 being at different height than 34. Items traveling through the mail must be closed/sealed in order to prevent the contents from spilling out (See e.g. US Patent No. 3,756,468 which discloses a sealable folder). Applicant has not disclosed that the folders are closeable. In

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fact, the fact that the folders have differently configured edges provides evidence that they are not entirely closeable or sealable or at least that there must be additional structure to make them sealable. Applicant has not shown in the figures nor disclosed in the specification how these folder devices could travel through the mail or be postage paid mail items.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-9, 11-12 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/20462 to Söderström (Söderström), published 5/14/98, in view of US Patent No. 6,453,589 to Schwartz (Schwartz), filed 2/9/99.

In regard to claims 1 and 7, Söderström discloses an apparatus comprising:

- a mail sorting device having a plurality of partition elements supported upon a frame, each of the partition elements having a configured leading edge, a plurality of compartments into which items are place in a generally upright manner, each of said plurality of compartments being at least partially defined between a pair of partition elements, and a bottom (See Fig. 1).

Söderström does not disclose a folder device for receiving items and being generally vertically supported upon the bottom, said folder device having a pair of sides, each side being

associated with one of the partition elements, each side having a forward edge, wherein the forward edges of the sides are at different heights relative to the leading edges of the associated partition elements.

However, Schwartz discloses a folder device (See e.g. 4a). It would be obvious to one of ordinary skill in the art that Schwartz's folder could be placed in the Söderström rack so that the folder's hinge (STH1) is along the bottom of the rack in order for the folder to hold mail. Further, there is motivation to use a file folder such Schwartz's to hold mail. It is well known in the art to use folders for the purpose of sorting mail (See e.g. US Patent 5,000,325 to D'Elia [D'Elia] or US Patent 5,547,226 to Wentworth [Wentworth]).

In regard to claims 2 and 8, Söderström discloses a bottom that is movable relative to the frame (see abstract).

In regard to claims 3 and 9, it is well known in the art that file folders have surfaces which can be labeled with identifying indicia. Schwartz discloses such a surface (T1). Schwartz does not specifically disclose that is what the surface is for, however, it is well known in the art (See e.g. Wentworth, abstract). Further, it would be obvious to one of ordinary skill in the art at the time the invention was made, to use an address indicia on the surface of the folder if the folder was used in a mail sorting function as disclosed above.

In regard to claims 5, 6, 11 and 12, Schwartz discloses a splay structure (STH1) which is generally planar.

In regard to claims 28 and 29, Schwartz discloses a reveal structure that is downwardly tapered (See e.g. Fig. 4).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kohner whose telephone number is 703-305-8496. The examiner can normally be reached on Mon-Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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